

DOCKET NO.: ISPH-0590
SERIAL NO.: 09/918,187

Remarks

Upon entry of the amendments submitted herewith, Claims 1, 4-7, 9, 10, 12-13, and 28 are currently pending in the instant application.

Applicants have herewith amended Claims 1 and 12, canceled claims 24-27 and added Claim 28. Applicants make said claim amendments and cancellations without prejudice to pursuing the originally presented or canceled subject matter in a later application claiming benefit of this application. The amendments to Claim 1 find support in the claims as originally filed and in the specification (see, for example, page 12, line 32). The amendment to Claim 12 finds support in the claims as originally filed. No new matter is added by this amendment. Newly introduced Claim 28 finds support in the claims as originally filed, and in the specification (see, for example, Example 15, pages 85-87).

Rejection Under 103(a)

Claims 1, 4-7, 9, 10, 12, and 13 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Stenn et al. in view of Baracchini et al. and McKay et al. Applicants believe that the rejection is rendered improper because each and every limitation of the claims as currently amended is not present in the combination of Stenn, Baracchini and McKay. Therefore, Applicants respectfully request that the rejection be reconsidered and withdrawn.

Newly introduced Claim 28 is identical to previously amended and canceled Claim 15. Applicants believe that this claim is in condition for allowance. In an Office Action dated 11/15/2004, the Examiner withdrew rejections of Claim 15 under 35 U.S.C. § 102(b) and 35 U.S.C. § 112, first paragraph, following amendments made to the claims by Applicants in a response dated 9/7/2004. However, Claim 15 was rejected under 35 U.S.C. § 103(a). In view of the current amendments to Claim 1, Applicants believe that this rejection of Claim 15 is rendered improper because the limitations of the claims are not present in the combination of Stenn, Baracchini and McKay.

Rejection Under 112

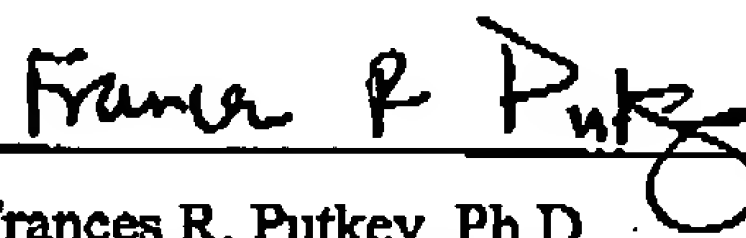
Claims 12 and 24-27 are rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement. Applicants have removed the word "pharmaceutical" from Claim 12, thus obviating the rejection against this claim. While Applicants disagree with the Examiner's position that the specification is not enabling for the practice of the invention *in vivo*, in an effort

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to expedite prosecution Applicants have canceled Claims 24-27. It is believed that Applicant's cancellation of Claims 24-27 renders the rejection under 35 U.S.C. § 112 moot. Applicants respectfully request that the rejection be reconsidered and withdrawn.

In summary, Applicants respectfully request that (i) the claim amendments be entered, (ii) the rejection of Claims 1, 4-7, 9, 10, and 12-13 be withdrawn, and (iii) Claims 1, 4-7, 9, 10, 12, 13, and 28 be allowed. If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned at (760) 603-2710. Please charge any deficiencies to Isis Pharmaceuticals, Inc., Deposit Account No. 50-0252, referencing Attorney Docket No. ISPH-0590.

Respectfully submitted,



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